

**REMARKS**

Claims 1, 3, 4, 6-12 and 14-35 remain in this application. Claims 1, 3, 4, 6-12 and 14-35 are rejected. Claims 2, 5 and 13 are previously cancelled. Claims 1, 3, 4, 6-10, 14-18 and 35 are amended herein to clarify the subject matter of the invention.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims and objection cited in the above-referenced Office Action.

Claims 1, 3, 4, 6-12 and 14-35 are rejected as obvious over Ng (US 5,971,855 in view of Pokemon and Hawkins (US 6,009,458) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection.

It is respectfully submitted that a *prima facie* case of obviousness could not be established in rejection of claims 1, 3, 4, 6-12 and 14-34 in their amended form. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

It is noted that the claims upon which the above rejection have been applied were indicated as allowable, based on the same combination of references, by the prior Examiner assigned to the present application. The present Examiner, however, appears to be giving a broader interpretation to the language of the claims, in making the rejections. While applicants respectfully disagree that the claims prior to their amendment herein are made obvious over the proffered combination of references, and for the reasons set forth in the previously filed amendment, the claims are amended to overcome the newly presented reasons for the rejections outlined in the Office Action.

The claims have been amended to clarify that communication is made between at least two game devices. In addition, the recitations directed to the training values have been revised to indicate that these training values are added to the training initial values of the set character "in accordance with actions taken by the character in line of a training purpose in response to the operation of the plurality of operable members."

The character data and items have been similarly clarified to distinguish over the cited art of record. The Examiner indicates that the claimed term "item" is broadly read to include "trading" objects, such as disclosed in Hawkins. The Examiner, therefore, appears to be of the position that the transmission of items of

the present invention is the same as the simple trading of game objects, i.e., merely for purposes of increasing the marketability of the game. However, the items, as claimed, serve a related functional purpose within the context of the game itself, and include the examples shown in Table 1 of the specification for present application (page 16). The items, therefore, when given to the game character, have influence on the character's performance when they are possessed by the character. Unique to the presently claimed invention, is the feature by which such influence accompanies the character when transferred to another game device, while at the same time, the training value is initialized upon the transferring of the character.

Applicants respectfully traverse the Examiner's position that the O.T. data disclosed in Pokemon is, according to any reasonable interpretation, equivalent to the initial training values of the presently claimed invention. Firstly, as claimed, and in contrast to Pokemon, a character has more than one training initial value. Secondly, said training initial values reflect at least one aspect of basic abilities of the character. The Examiner's reasoning that "the O.T. data reflects at least one aspect of the basic abilities of the character" (page 8 of the Office Action) does not survive logical scrutiny for just one aspect of ability, let alone more than one aspect. Merely knowing the identity of the original trainer could not possibly indicate inherent ability or abilities of a character. In the real world, for example, if one trainer were to train several athletes, all with differing starting abilities, one could not tell how these athletes differed in initial basic abilities merely by knowing the identity of the

original trainer (O.T.). Similarly one could not tell any individual ability among perhaps many different abilities of any given athlete, simply by learning the identity (O.T.) of his/her initial trainer.

Furthermore, nothing in any of the prior art cited suggests transfer of such initial training values representative of basic ability such that a “user of the second game device can begin training of the character with said training initial values” and, because the data in Pokemon pertains only to a trainer and not a basic ability of the character itself, such data in Pokemon could not possibly be used as a basis of retraining.

Therefore, it is applicants’ position that one of ordinary skill in the art would not receive the requisite teaching, or be motivated, to transmit data representing the training initial values as set before training thereby by a first player to another game terminal, for use of these same values as a starting point for retraining by a subsequent game player, after successful training by the preceding game player. The claimed invention provides a second game player with the training values set initially before training is performed by a first game player, so that the second game player can start the retraining with the same values used by the first player who has already successfully trained the character, a feature absent from the cited references. Thus, the prior art references fail to teach or suggest all the claim limitations as properly required for establishing a *prima facie* case of obviousness.

In summation, the significant differences of claimed invention from the cited art taken in combination are outlined below:

(1) The character is transmitted to the other game machine when it is judged that the character has been trained successfully. While the teaching of the cited references may indicate a form of training judge, the references do not show that the result of the judgment is used as claimed.

(2) The training values are initialized upon the transmission of the character to restart the training of the character from its initial training value, while, in contrast, trained values are utilized in Pokemon; and

(3) The items given to the character while being trained in a first game device are transmitted along with the character to the second game machine to exert influence on the character when trained in the second game device.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited references for the reasons stated above. Reconsideration of the rejections of claims 1, 3, 4, 6-12 and 14-35 and their allowance are respectfully requested.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By Frank J. Jordan by :  
Frank J. Jordan  
Reg. No. 20,456  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

Jimmy D. D. D.  
Reg No. 36,049